

REMARKS

N.B. Applicant requests the Examiner, in his next communication, to acknowledge Applicant's claim for foreign priority. (The undersigned attorney has requested from Applicant a certified copy of the foreign priority document, and will file the copy as soon as received.)

Applicant requests the Examiner to reconsider and withdraw the rejection under 35 U.S.C. § 112, second paragraph, in view of the above amendments which insert the missing symbol "x" in the specified expressions in claims 1, 2, 5, 6 and 7, and also in the corresponding expressions in the specification. Applicant also amends the penultimate line of specification page 4 to insert a missing inequality symbol, and amends to correct other obvious errors.

With respect to the Office Action at page 3, paragraph 5, in view of the above amendments to claim 7, the Examiner is requested now to **allow claims 7 and 8**.

Applicant respectfully traverses the rejection of claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable (obvious) over Pedarre '515. The Examiner did not list Pedarre '515 on the attached Form PTO-892 or provide Applicant with a copy of this reference; however, Applicant obtained its own copy of the reference.

Pedarre '515 describes ferritic stainless steels with "improved machinability". While it is true that the composition ranges of Pedarre overlap the composition ranges of the steels used in the present invention, there is **nothing said** in Pedarre about the **magnetic properties** of these steels, and there is **no suggestion** that some steels, within the wide composition described and claimed therein, could be advantageously used in the field of **ferromagnetic steel parts**. Rather,

the main use of the steels disclosed in Pedarre '515 is screw-machining, as stated in col. 3, l. 64, and in claim 1.

Thus, Applicant respectfully submits that the rejection on Pedarre '515 does not produce a *prima facie* showing of obviousness of the subject matter defined in each of claims 1-6. That is, Pedarre '515 does not teach, and would not have suggested, to a person of ordinary skill in the art the subject matter, taken as a whole, of each of claims 1-6.

The ultimate question to be answered, in deciding whether or not a claimed invention, taken as a whole would have been obvious from the prior art, is **exactly** what said prior art would have **taught** or **suggested** to the ordinarily skilled person **at the time the claimed invention was made**. Applicant respectfully submits that Applicant's claimed "ferromagnetic stainless steel parts", made of a steel as defined in claims 1-6, simply would not have been suggested (would not have been obvious) to the ordinarily skilled person from a reading of Pedarre's **entire** disclosure which is directed to "improved machinability" of a ferritic stainless steel.

As for the question of overlapping ranges in Applicant's claims and in Pedarre's disclosure, it is well settled in case law that such claims may be patentable if the claims do not read on a specific embodiment of the applied reference, and if the claimed subject matter produces a non-obvious (unexpected) result not found in the prior art. Here, Applicant respectfully submits that claims 1-6 meet both requirements, and also refers the Examiner to MPEP §2131.03 (last paragraph).

N.B. Applicant refers Examiner Sheehan to copending application No. 10/303,000 which is under examination by Examiner Jenkins in Art Unit 1742. The present application and the

copending application are directed to similar subject matter. The copending application was filed on November 24, 2002, claiming a foreign priority date of November 26, 2001.

The copending application is assigned to USINOR, while the present application is assigned to UGINE SAVOIE IMPHY, a 100% owned subsidiary of USINOR. These Assignees are members of the USINOR group of companies. Furthermore, inventors Christophe Bourgin and Pollet are common to both the present and the copending applications. Furthermore, UGINE SAVOIE, the Assignee listed on the face of Padarre '515, is the former name of UGINE SAVOIE IMPHY.

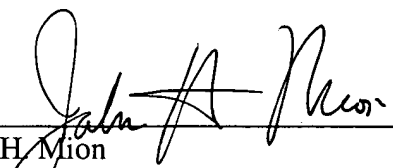
If for any reason the Examiner feels that the application is not now in condition for allowance with claims 1-6, together with the **allowable** claims 7 and 8, he is respectfully requested to **call the undersigned attorney** to discuss any unresolved issues and to expedite the disposition of the application.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this application, and any required fee for such extension is to be charged to

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO. 10/092,448

Deposit Account No. 19-4880. The Commissioner is also authorized to charge any additional fees under 37 C.F.R. § 1.16 and/or § 1.17 necessary to keep this application pending in the Patent and Trademark Office or credit any overpayment to said Deposit Account No. 19-4880.

Respectfully submitted,



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